

REMARKS

This Amendment is in response to the Office Action mailed 12/01/2004. In the Office Action, the Examiner rejected claims 1-42 under 35 U.S.C. § 103. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejections Under 35 U.S.C. § 103

3. The Examiner rejects claims 1-3, 6-8, 12-14, and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over Akhtar et al. (US 6, 172,973).

Referring to claims 1 and 12, the Examiner admits that Akhtar does not disclose converting to and from VoIP and VoFR. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to implement VoIP and VoFR in the Akhtar system because VoIP and VoFR were known standards. Applicant respectfully disagrees. Applicant previously presented the following argument on page 16 of the Response filed on 10/15/2004. The Examiner did not respond to this argument in the Office Action of 12/01/2004. Applicant respectfully submits that this argument is still valid despite the new grounds of rejection and asks for reconsideration.

Akhtar teaches a system that inserts an ATM network between two standard TDM endpoints and provides common channel signaling for end to end control without repeated conversion delays. Abstract. Akhtar teaches the use of a voice switch that is connected to a TDM network on one side and an ATM network on the other side. Nothing in Akhtar teaches or suggests means for switching between more than one signaling type on either side of the voice switch much less on both sides as claimed. That other signaling types were known would not make it obvious to modify Akhtar as suggested by the Examiner. Nothing in Akhtar teaches or suggests a voice switch that can accept more than one type of signaling at a connection. The

mere fact that other signaling types were known and that their use is desirable is not sufficient to provide a motivation to modify the teachings of Akhtar so that the disclosed voice switch could accept a connection that carries more than one type of media. Since Akhtar teaches a voice switch that performs a predefined one-to-one translation there would be no expectation of success in modifying the voice switch to handle a many-to-many translation as claimed.

The Examiner asserts that Akhtar teaches signaling information of the TDM connections is relayed through the ATM connections citing figure 3, claim 1, and the abstract. Applicant respectfully disagrees. Applicant previously presented the following argument on page 17 of the Response filed on 10/15/2004. The Examiner did not respond to this argument in the Office Action of 12/01/2004. Applicant respectfully submits that this argument is still valid despite the new grounds of rejection and asks for reconsideration.

Akhtar teaches that "control is accomplished in parallel over the standard public switch telephone network while the voice 'data' is transported over an ATM 'data' network." [emphasis added] Abstract. Thus Akhtar teaches away from "relaying signaling associated with said voice call of said first signaling type to a second signaling type corresponding to said second media type" as claimed.

Referring to claims 2 and 13, applicant relies on the patentability of the claims from which these claims depend to traverse the rejection without prejudice to any further basis for patentability of these claims based on the additional limitations recited.

Referring to claims 3 and 14, the Examiner asserts that Akhtar discloses that the system comprises means for associating said voice call with a quality of service requirement, citing column 2, lines 1-18, and column 3, lines 40-57. The cited portions disclose that the system operates to minimize the end to end delay of the system which results in a higher quality of

service. This does not disclose associating a call with a quality of service requirement. The system disclosed by Akhtar operates to provide a higher quality of service for all calls. Akhtar does not disclose anything with respect a quality of service requirement for any specific call. Indeed, there is nothing the system of Akhtar can change in response to a QoS requirement of a specific call so there would be no motivation for Akhtar to associate a QoS with a call.

Referring to claims 6 and 17, applicant relies on the patentability of the claims from which these claims depend to traverse the rejection without prejudice to any further basis for patentability of these claims based on the additional limitations recited.

Referring to claims 7 and 18, applicant relies on the patentability of the claims from which these claims depend to traverse the rejection without prejudice to any further basis for patentability of these claims based on the additional limitations recited.

Referring to claims 8 and 19, applicant relies on the patentability of the claims from which these claims depend to traverse the rejection without prejudice to any further basis for patentability of these claims based on the additional limitations recited.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-4, 6-8, 12-15, and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over Akhtar in view of Mitra.

4. The Examiner rejects claims 4 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Akhtar in view of Mitra (US 6,331,986).

The Examiner admits that Akhtar does not disclose means for determining said second media type in accordance with a service plan profile of a calling party associated with the voice call. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at

the time of the invention to implement a system wherein a network operator uses service level agreements it has with their customers (i.e. calling parties), in order to provide different service types (i.e. media types)(see column 4 lines 47-53) as disclosed by Mitra. Applicant respectfully disagrees.

In response to applicant's argument that the SLA of Mitra is not related to particular voice calls, the Examiner responds by arguing that since every call is affected by the SLA, the SLA therefore relates to particular calls. The Examiner further argues that "a service plan" as recited in the claims does not limit the plan to only particular calls.

Applicant has amended claims 3 and 4 such that it is more clearly pointed out and distinctly claimed that the quality of service requirement is specific to the voice call being processed and that the service plan profile is specific to the calling party associated with the voice call. Applicant respectfully submits that the claim as amended is clearly distinguished from Akhtar which does not disclose associating a quality of service with a specific call and from Mitra which does not disclose a service plan profile that is specific to a calling party.

5. The Examiner rejects claims 5, 9-11, 16, and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over Akhtar in view of Mitra and further in view of Lee (US 6,252,847).

Referring to claims 5 and 16, the Examiner admits that Akhtar does not disclose that the switching system determines the said second media type in accordance with instantaneous availability of bandwidth resources. The Examiner asserts that Lee discloses an ATM cell transmission system comprising means for determining said second media type in accordance with instantaneous availability of bandwidth resources, citing column 1 lines 25-28, column 1 lines 55-58, and column 2 lines 44-50. Applicant respectfully disagrees. Applicant understands

Lee to teach an algorithm used to provide explicit rate (ER) values to available bit rate (ABR) cell traffic in an ATM network. Abstract. Lee teaches that the media type will always be ABR and that an ER will be calculated and used to control the transmission rate of ABR traffic during network congestion conditions. Col. 1, lines 55-65. Nothing in Lee, Akhtar, or Mitra teaches or suggests the selection of a second media type. Further there is nothing in Akhtar that teaches or suggests that the voice call can be converted to a second media type; therefore, there is no reasonable expectation of success for combining a teaching of conversion of media type with Akhtar.

Referring to claims 9 and 20, applicant relies on the patentability of the claims from which these claims depend to traverse the rejection without prejudice to any further basis for patentability of these claims based on the additional limitations recited.

Referring to claims 11 and 22, the Examiner has grouped these claims with claims 9 and 20. However, the Examiner present no argument directed to the additional elements of these claims in the discussion of that group. These claims include the element of determining said second media type in accordance with a service plan profile of a calling party associated with said voice call. Applicant discusses claims 11 and 22 with claims 10 and 21 following.

Referring to claims 10, 11, 21, and 22, the Examiner admits that Akhtar does not disclose means for determining said quality of service requirement in accordance with a service plan profile of a calling party associated with the voice call. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to implement a system wherein a network operator uses service level agreements it has with their customers (i.e. calling parties), in order to determine and provide quality of service requirements (see column 4 lines 47-53) as disclosed by Mitra.

In response to applicant's argument that the SLA of Mitra is not related to particular voice calls, the Examiner responds by arguing that since every call is affected by the SLA, the SLA therefore relates to particular calls. The Examiner further argues that "a service plan" as recited in the claims does not limit the plan to only particular calls.

Applicant has amended claims 10, 11, 21, and 22 such that it is more clearly pointed out and distinctly claimed that the quality of service requirement is specific to the voice call being processed and that the service plan profile is specific to the calling party associated with the voice call. Applicant respectfully submits that the claim as amended is clearly distinguished from Akhtar which does not disclose associating a quality of service with a specific call and from Mitra which does not disclose a service plan profile that is specific to a calling party.

The disclosure of service level agreements (SLAs) by Mitra is not a disclosure of "a service plan profile of a calling party" as used in this application. As discussed on page 49, lines 3-6, of the specification as filed, service plan profiles are maintained by the call server for individuals or groups of users. It would be understood by one of ordinary skill in the art that "a service plan profile of a calling party" as used in this application refers to information maintained by the carrier class switch apparatus to control how the switch handles calls placed by various calling parties that use the switch to place telephone calls to be received and relayed by the switch. Service level agreements as used by Mitra are agreements between a service provider (i.e. the operator of the network to which a switch is attached) and an operator of a device that uses the provided service (i.e. the operator of the switch). SLAs are contracts that define what service will be provided in bulk. An SLA would at best define what minimum level of quality of service is to be provided by the service provider. The SLA would not associate a particular voice call with a quality of service requirement. There is no motivation to combine SLAs as taught by

Mitra with the system of Akhtar as suggested by the Examiner because Akhtar does not teach or suggest a system that can respond to a quality of service requirement. There would be no reasonable expectation of success in combining SLAs as taught by Mitra with the system of Akhtar because the system of Akhtar is predefined with regard to what quality of service it will provide.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 5, 9-11, 16, and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over Akhtar in view of Mitra and further in view of Lee.

6. The Examiner rejects claims 23 and 25-29 under 35 U.S.C. § 103(a) as being unpatentable over Bartholomew et al. (US 5,712,903) in view of Mitra.

Referring to claim 23, the Examiner admits that Bartholomew does not disclose converting to and from VoIP and VoFR. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to implement VoIP and VoFR in the Bartholomew system because VoIP and VoFR were known standards. Applicant respectfully disagrees.

In response to applicant's argument that there is no motivation for implementing the gateway of Bartholomew so that other media types can be used, the Examiner responds by arguing that adding the other media types in the Bartholomew system would allow the system to accommodate more users making the system more flexible and versatile.

The Federal Circuit has stated that the showing of a motivation to combine must be clear and particular and that broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. "Our case law makes clear that the best defense

against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir., 1999).

Here the Examiner appears to apply impermissible hindsight by using Applicant's disclosure as a guide. The essence of the Examiner's argument is that adding additional known capabilities to the Bartholomew system would make the system better, therefore it was obvious to add those features. This is the type of broad conclusory statement that the court disapproved of in *Dembiczak*. Applicant respectfully submits that the Examiner has not provided real evidence of a suggestion, teaching, or motivation to combine flowing from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. Therefore, the Examiner has not made out a *prima facie* case of obviousness.

Further, the Examiner has not addressed applicant's previously presented argument that since Bartholomew teaches a gateway switch that performs a predefined one-to-one translation there would be no expectation of success in modifying the gateway switch to handle a many-to-many translation as claimed. Evidence of a reasonable expectation of success is another element for a *prima facie* case of obviousness, an element that the Examiner has not provided.

Referring to claim 25, applicant relies on the patentability of the claims from which this claim depends to traverse the rejection without prejudice to any further basis for patentability of this claim based on the additional limitations recited.

Referring to claim 26, applicant relies on the patentability of the claims from which this claim depends to traverse the rejection without prejudice to any further basis for patentability of this claim based on the additional limitations recited.

Referring to claims 27, 28, and 29, applicant relies on the patentability of the claims from which these claims depend to traverse the rejection without prejudice to any further basis for patentability of these claims based on the additional limitations recited.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 23 and 25-29 under 35 U.S.C. § 103(a) as being unpatentable over Bartholomew in view of Mitra.

7. The Examiner rejects claims 24 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Bartholomew in view of Mitra and further in view of Chu et al. (US 5,956,334).

Referring to claim 24, applicant relies on the patentability of the claims from which this claim depends to traverse the rejection without prejudice to any further basis for patentability of this claim based on the additional limitations recited.

Referring to claim 30, applicant relies on the patentability of the claims from which this claim depends to traverse the rejection without prejudice to any further basis for patentability of this claim based on the additional limitations recited.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 24 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Bartholomew in view of Mitra and further in view of Chu.

8. The Examiner rejects claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Bartholomew in view of Mitra and Chu and further in view of Rathnavelu (US 5,914,934).

Referring to claim 31, applicant relies on the patentability of the claims from which this claim depends to traverse the rejection without prejudice to any further basis for patentability of this claim based on the additional limitations recited.

Applicant respectfully requests that the Examiner withdraw the rejection of claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Bartholomew in view of Mitra and Chu and further in view of Rathnavelu.

9. The Examiner rejects claims 32-35 and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over Akhtar in view of Mitra.

The Examiner rejects claims 32-35 and 37-39 for the same reasons as claims 12-15 and 17-19 respectively. Applicant likewise traverses the rejections on the same basis as discussed above for claims 12-15 and 17-19.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 32-35 and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over Akhtar in view of Mitra.

10. The Examiner rejects claims 36 and 40-42 under 35 U.S.C. § 103(a) as being unpatentable over Akhtar in view of Mitra and further in view of Lee (US 6,252,847).

Referring to claim 36 and 42, the Examiner admits that Akhtar does not disclose that the switching system determines the said second media type in accordance with instantaneous availability of bandwidth resources. The Examiner asserts that Lee discloses an ATM cell transmission system comprising means for determining said second media type in accordance with instantaneous availability of bandwidth resources, citing column 1 lines 25-28, column 1 lines 55-58, and column 2 lines 44-50. Applicant respectfully disagrees. Applicant understands Lee to teach an algorithm used to provide explicit rate (ER) values to available bit rate (ABR) cell traffic in an ATM network. Abstract. Lee teaches that the media type will always be ABR and that an ER will be calculated and used to control the transmission rate of ABR traffic during

network congestion conditions. Col. 1, lines 55-65. Nothing in Lee, Akhtar, or Mitra teaches or suggests the selection of a second media type. Further there is nothing in Akhtar that teaches or suggests that the voice call can be converted to a second media type; therefore, there is no reasonable expectation of success for combining a teaching of conversion of media type with Akhtar.

Referring to claim 40, applicant relies on the patentability of the claims from which this claim depends to traverse the rejection without prejudice to any further basis for patentability of this claim based on the additional limitations recited.

Referring to claims 41 and 42, the Examiner admits that Akhtar does not disclose means for determining said quality of service requirement in accordance with a service plan profile of a calling party associated with the voice call. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to implement a system wherein a network operator uses service level agreements it has with their customers (i.e. calling parties), in order to determine and provide quality of service requirements (see column 4 lines 47-53) as disclosed by Mitra.

In response to applicant's argument that the SLA of Mitra is not related to particular voice calls, the Examiner responds by arguing that since every call is affected by the SLA, the SLA therefore relates to particular calls. The Examiner further argues that "a service plan" as recited in the claims does not limit the plan to only particular calls.

Applicant has amended claims 41 and 42 such that it is more clearly pointed out and distinctly claimed that the quality of service requirement is specific to the voice call being processed and that the service plan profile is specific to the calling party associated with the voice call. Applicant respectfully submits that the claim as amended is clearly distinguished

from Akhtar which does not disclose associating a quality of service with a specific call and from Mitra which does not disclose a service plan profile that is specific to a calling party.

The disclosure of service level agreements (SLAs) by Mitra is not a disclosure of "a service plan profile of a calling party" as used in this application. As discussed on page 49, lines 3-6, of the specification as filed, service plan profiles are maintained by the call server for individuals or groups of users. It would be understood by one of ordinary skill in the art that "a service plan profile of a calling party" as used in this application refers to information maintained by the carrier class switch apparatus to control how the switch handles calls placed by various calling parties that use the switch to place telephone calls to be received and relayed by the switch. Service level agreements as used by Mitra are agreements between a service provider (i.e. the operator of the network to which a switch is attached) and an operator of a device that uses the provided service (i.e. the operator of the switch). SLAs are contracts that define what service will be provided in bulk. An SLA would at best define what minimum level of quality of service is to be provided by the service provider. The SLA would not associate a particular voice call with a quality of service requirement. There is no motivation to combine SLAs as taught by Mitra with the system of Akhtar as suggested by the Examiner because Akhtar does not teach or suggest a system that can respond to a quality of service requirement. There would be no reasonable expectation of success in combining SLAs as taught by Mitra with the system of Akhtar because the system of Akhtar is predefined with regard to what quality of service it will provide.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 36 and 40-42 under 35 U.S.C. § 103(a) as being unpatentable over Akhtar in view of Mitra and further in view of Lee.

Appl. No.
Amdt. dated 04/01/2005
Reply to Office Action of

Conclusion

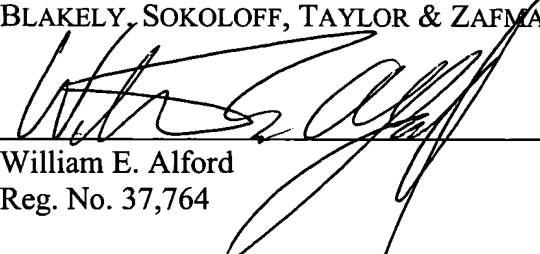
Applicant reserves all rights with respect to the applicability of the doctrine of equivalents. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The Examiner is invited to contact Applicant's counsel by telephone at (714) 557-3800 to expedite the prosecution of this case should there be any unresolved matters remaining. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such deposit account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: April 1, 2005



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 on:
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Pat Sullivan

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4/1/05

Date